



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,536	01/12/2001	Carl Teo Balbach	31215.new	1174

7590 08/06/2004

R. Kent Roberts
Hodgson, Russ, Andrews,
Woods & Goodyear LLP
One M&T Plaza, Suite 2000
Buffalo, NY 14203-2391

EXAMINER

OUELLETTE, JONATHAN P

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/759,536	Applicant(s) BALBACH, CARL TEO	
	Examiner Jonathan Ouellette	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>20040414</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
2. **Claims 1-4, 6-11, 15-19, 21-26, and 30-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hedloy et al. (US 6,323,853 B1).**
3. **As per independent Claims 1, 16, 30, and 41**, Hedloy discloses a method (article of manufacture, system) of selecting contact information, comprising: analyzing a document to determine a referenced entity identified in the document (Abstract); providing a data base of contact entities (Fig.1b), the data base having information corresponding to a plurality of contact entities; determining whether the referenced entity is among the contact entities; and if the referenced entity is among the contact entities, then selecting the contact information corresponding to the referenced entity (Abstract, Fig.1b, C10 L5-9).
4. Hedloy fails to expressly disclose analyzing an electronic source document available on a network of computers.
5. However, Hedloy does disclose using the contact information management/search system with electronic documents (C9 L50-64), and it would have been obvious to use the

system with an electronic source document available on a network of computers, as such documents were well known at the time the invention was made and easily integrated with the database search system described by Hedloy.

6. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an electronic source document available on a network of computers, in the system disclosed by Hedloy, for the advantage of providing a method of selecting contact information, with the ability to increase effectiveness of the system by providing the user with a multitude of documents/document formats to search for contact information.
7. Claims 2-4, 6-11, 15, 17-19, 21-26, 31-40, and 42-43 are rejected as they are based on rejected independent claims.
8. **As per independent Claim 44**, Iinuma discloses a method of providing a sender with contact information, comprising: analyzing a document to determine a plurality of referenced entities identified in the document (Abstract); providing a data base of contact entities (Fig.1b), the data base having information corresponding to a plurality of contact entities; determining whether the referenced entities are among the contact entities; providing a list of referenced entities [information items] that are among the contact entities [selected referenced entity]; selecting from the list of referenced entities one of the referenced entities; selecting the contact information corresponding to the selected referenced entity (automation is inherent to the system disclosed by Iinuma); and providing the selected contact information to the sender (Abstract, Fig.1b, C7 L16-62, C10 L5-9).

9. Hedloy fails to expressly disclose analyzing an electronic source document available on a network of computers.
10. However, Hedloy does disclose using the contact information management/search system with electronic documents (C9 L50-64), and it would have been obvious to use the system with an electronic source document available on a network of computers, as such documents were well known at the time the invention was made and easily integrated with the database search system described by Hedloy.
11. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included an electronic source document available on a network of computers, in the system disclosed by Hedloy, for the advantage of providing a method of selecting contact information, with the ability to increase effectiveness of the system by providing the user with a multitude of documents/document formats to search for contact information.
12. Claims 45-47 are rejected as they are based on a rejected independent claim.
13. **Claims 5, 12-14, 20, and 27-29 are rejected under 35 U.S.C. 103 as being unpatentable over Hedloy.**
14. As per Claims 5 and 20, Hedloy does not expressly show wherein analyzing the message to determine whether the message satisfies criteria specified by the referenced entity includes determining whether the message has obscenities therein.
15. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of selecting contact information would be performed regardless of the type of message criteria used. Thus,

this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have determined whether the message satisfied the criteria specified by the referenced entity, which included determining whether the message had obscenities therein, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.
17. As per Claims 12-14 and 27-29, Hedloy does not expressly show wherein the contact information includes a postal address, Internet address, or phone number.
18. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The method of selecting contact information would be performed regardless of the type of contact information used. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
19. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a postal address, Internet address, or phone number as contact information, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

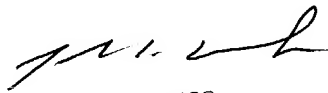
20. Applicant's arguments filed 4/26/04, with respect to Claims 1-47, have been considered but are moot in view of the new ground(s) of rejection.
21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
22. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Conclusion

23. Additional Non-Patent Literature has been referenced on the attached PTO-892 form, and the Examiner suggests the applicant review these documents before submitting any amendments.

24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (703) 605-0662. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.
26. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

jo
August 2, 2004


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600